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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,239

09/24/2004

Johannes Johanna Van Herk

NL 020256

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10/08/2008

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

HOLMES, REX R

ART UNIT

PAPER NUMBER

3762

MAIL DATE

DELIVERY MODE

10/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/509,239	<b>Applicant(s)</b> VAN HERK ET AL.	
	<b>Examiner</b> REX HOLMES	<b>Art Unit</b> 3762	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,6 and 13-17 is/are allowed.
- 6) ☒ Claim(s) 7-12 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7, 11 and 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Byers et al. (U.S. Pat. 4,969,468 hereinafter "Byers") in view of Booker et al. (U.S. Pub. 2003/0114906 hereinafter "Booker").

Regarding claims 7, 11 and 18, Byers discloses a electrode array for sensing physiological signals through the skin, made out of a conductive flexible/stretchable material with projections made out of metal that are arranged in a uniform pattern on the surface of the electrode (e.g. Col. 7, ll. 18-25; Col. 10, ll. 22-30; Col. 12, ll. 25-40; Figs. 4-6). Byers further discloses that the electrode body is sandwiched between two insulating layers with the tips of the projections sticking through the layers (e.g. Fig. 4 ("8" & "10") & Col. 6, ll. 38-53) but fails to disclose that the projections and electrode backing are elastic and are used in combination with a storage and analysis device. However Booker discloses a system for monitoring ecg, evaluating ecg and then stimulating that utilizes elastic electrodes (23) with elastic projections (23) to provide a

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electrode that can conform to tissue so that it maintains constant contact(Fig. 9, ¶42). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Byers, with elastic electrodes and projections as taught by Booker, since such a modification would provide the electrodes and projections with elastic properties for providing the predictable result of elastic electrodes with projections that conform to tissue and maintain constant contact without moving.

4. Regarding claims 8-10 and 20, Byers in view of Booker teaches the claimed invention except for the elastic layer being a conductive rubber and the insulating layers being plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the elastic layer with a conductive rubber and the insulating layer with a plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byers in view of Booker as applied to claim 7 above, and further in view of Ingman (U.S. Pub. 2002/0082668).

6. Regarding claim 12, Byers in view of Booker discloses the claimed invention except for the holes to collect sweat and prevent short circuiting. Ingman teaches that it is known to use holes in the electrode as set forth in Paragraph 16 to prevent sweat from short circuiting the conducting layer of the electro-patch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to

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modify the electrode as taught by Byers in view of Booker, with holes through the electrode as taught by Ingman, since such a modification would provide the predictable result of a electrode with holes to prevent sweat from short circuiting the conducting layer of the electrode. Further it would have been obvious to one having ordinary skill in the art to put the holes between the projections as the only place to put the holes in the body of the electrode would be in the spaces between the projections.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byers in view of Booker and further in view of Granek et al. (U.S. Pat. 4,729,377 hereinafter "Granek").

Regarding claim 19, Byers in view of Booker discloses a electrode array for sensing physiological signals through the skin, made out of a conductive flexible/stretchable material with projections made out of metal that are arranged in a uniform pattern on the surface of the electrode but fails to disclose that the electrodes are positioned on a garment. However Granek discloses a system that uses a garment to connect and hold flexible electrodes near the body in a secure way for sensing and stimulation purposes as set forth in Columns one and two. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Byers, with a garment to secure electrodes to the body as taught by Granek, since such a modification would provide the predictable results of a way of holding electrodes with a garment for providing a secure way to position electrodes on a body in a comfortable and organized way.

***Allowable Subject Matter***

8. Claims 1-2, 6, 13-17 allowed.
9. The following is a statement of reasons for the indication of allowable subject matter: The subject matter not found was a electrode having a body of electrically conductive elastic material with projection of the electrically elastic material in combination with the other elements in the claims.

***Response to Arguments***

10. Applicant's arguments filed 8/25/08 regarding claims 7-12 and 18-20 have been fully considered but they are not persuasive. Applicant argues that Byers in view of Booker as there is no reason to combine these references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Byers and Booker both disclose electrodes for use on human tissue and thus teach of analogous art. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Byers, with elastic electrodes and projections as taught by Booker, since such a modification would provide the electrodes and projections with elastic properties for providing the predictable result of elastic

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electrodes with projections that conform to tissue and maintain constant contact without moving.

11. Applicant's arguments, see Applicant Remarks, filed 8/25/08, with respect to claims 1-2, 6, 13-17 have been fully considered and are persuasive. The rejection of claims 1-2, 6, 13-17 under 35 USC 103 has been withdrawn.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REX HOLMES whose telephone number is (571)272-8827. The examiner can normally be reached on M-F 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. H./

Examiner, Art Unit 3762

/George R Evanisko/

Primary Examiner, Art Unit 3762